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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,457	06/28/2001	Kenichi Sameshima	010825	2154
23850	7590	12/09/2004	EXAMINER	
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP			SHOSHO, CALLIE E	
1725 K STREET, NW			ART UNIT	
SUITE 1000			PAPER NUMBER	
WASHINGTON, DC 20006			1714	

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/892,457

Applicant(s)

SAMESHIMA ET AL.

Examiner

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. All outstanding rejections except for those described below are overcome by applicants' amendment filed 9/14/04.

In light of the new grounds of rejection as set forth below, the following action is non-final.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper (U.S. 2,869,194) in view of Meyer (U.S. 4,264,760).

The rejection is adequately set forth in paragraph 7 of the office action mailed 3/6/04 and is incorporated here by reference.

4. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerber (U.S. 5,294,649).

Gerber discloses composition comprising phenolic resole, powdered or granulated magnesium oxide or magnesium hydroxide, and ammonium thiosulfate. The composition is hardened or cured at 15-49 °C and can also be thermally cured either before or after the hardening at 77-100 °C. The magnesium oxide or magnesium hydroxide and ammonium thiosulfate are present, based on amount of resole, in amounts of 5-40% and 0.01-5%,

respectively, which overlap the amounts presently claimed (col.1, lines 19-22, col.5, lines 45-55 and 61-66, col.6, lines 34-35, col.7, lines 60-64, col.9, line 51, col.11, lines 56-59, col.12, lines 45-46 and 53, and col.14, lines 53-57).

While Gerber et al. do not exemplify ammonium thiosulfate as presently claimed nor can the claimed ammonium thiosulfate be "clearly envisaged" from Gerber as required to meet the standard of anticipation (cf. MPEP 2131.03), nevertheless, in light of the overlap between the claimed resin composition and Gerber, and absent evidence to the contrary, it is urged that it would have been obvious to, as well as within the skill level of, one of ordinary skill in the art, to utilize a resin composition which is both disclosed by Gerber and encompassed within the scope of the present claims, and thereby arrive at the claimed invention.

Response to Arguments

5. Previously, the examiner argued that while Cooper do disclose the use of filler in addition to resole and powdered magnesium oxide and while it is recognized that that the phrase "consisting essentially of" narrows the scope of the claims to the specified materials and those which do not materially affect the basic and novel characteristics of the claimed invention, absent a clear indication of what the basic and novel characteristics are, Cooper was still applicable against the present claims and "consisting essentially of" was construed as equivalent to "comprising". Further, it was noted that the burden was on the applicant to show that the additional ingredients in the prior art, i.e. filler, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant's invention, See MPEP 2111.03.

In response, applicants point to page 7, lines 7-9 of the present specification as support for the recitation of “consisting essentially of” transitional language and argue that such claim language would exclude other added components such as filler.

However, while it is agreed that there is support for the recitation of “consisting essentially of” in the present claims, it is not agreed that such claim language automatically excludes the use of all other ingredients except adventitious components. While “consisting of” transitional language would exclude the use of any other ingredients except those claimed, “consisting essentially of” excludes those that would affect the basic and novel characteristics of the claimed invention.

As set forth in MPEP 2111.03, absent a clear showing of what the basic and novel characteristics are, “consisting essentially of” is construed as equivalent to “comprising”. Further, the burden is on the applicant to show that the additional ingredients in the prior art, i.e. filler, would in fact be excluded from the claims and that such ingredients would materially change the characteristics of the applicant’s invention. Applicants have not made such a showing.

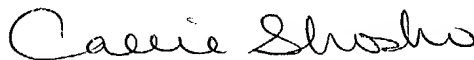
While applicants argue that filler would be excluded from “consisting essentially of” claim language, applicants provide no evidence to support their position or any showing as set forth in MPEP 2111.03 that the filler would in fact materially change the basic and novel characteristics of the invention. Absent such evidence, “consisting essentially of” is construed as equivalent to “comprising”, and thus, Cooper remains a relevant reference against the present claims.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
12/6/04